

ESTTA Tracking number: **ESTTA315716**

Filing date: **11/06/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91192099
Party	Defendant McSweet, LLC
Correspondence Address	Katherine Hendricks Hendricks & Lewis PLLC 901 5th Avenue, Suite 4100 Seattle, WA 98164-2001 UNITED STATES kh@hllaw.com
Submission	Answer and Counterclaim
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Signature	/Katherine Hendricks/
Date	11/06/2009
Attachments	89098.PDF (10 pages)(361324 bytes)

Registrations Subject to the filing

Registration No	1118362	Registration date	05/15/1979
Registrant	MCDONALD'S CORPORATION ONE MCDONALD'S PLAZA OAK BROOK, IL 60523-190 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 029. First Use: 1976/08/30 First Use In Commerce: 1976/08/30 All goods and services in the class are requested, namely: PREPARED FOOD PRODUCT CONSISTING PRINCIPALLY OF CHEESE, TOMATO, AND SEASONINGS TO BE USED ON TOAST

Registration No	1450104	Registration date	07/28/1987
Registrant	MCDONALD'S CORPORATION ONE MCDONALD'S PLAZA OAK BROOK, IL 60523 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 042. First Use: 1980/04/00 First Use In Commerce: 1980/04/00 All goods and services in the class are requested, namely: RESTAURANT SERVICES
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Registration No	1541797	Registration date	05/30/1989
Registrant	MCDONALD'S CORPORATION MCDONALD'S PLAZA OAK BROOK, IL 60521		

	UNITED STATES
Grounds for filing	The registered mark has been abandoned.

Goods/Services Subject to the filing

Class 032. First Use: 1987/11/18 First Use In Commerce: 1987/11/18
All goods and services in the class are requested, namely: SOFT DRINKS FOR CONSUMPTION ON OR OFF THE PREMISES

Registration No	1552143	Registration date	08/15/1989
Registrant	MCDONALD'S CORPORATION MCDONALD'S PLAZA OAK BROOK, IL 60521 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 029. First Use: 1988/05/20 First Use In Commerce: 1988/05/20
All goods and services in the class are requested, namely: CHILI FOR CONSUMPTION ON AND OFF THE PREMISES

Registration No	1566184	Registration date	11/14/1989
Registrant	MCDONALD'S CORPORATION MCDONALD'S PLAZA OAK BROOK, IL 60521 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 030. First Use: 1988/06/17 First Use In Commerce: 1988/06/17
All goods and services in the class are requested, namely: SOFT SERVE ICE MILK SUNDAES FOR CONSUMPTION ON OR OFF THE PREMISES

Registration No	1943180	Registration date	12/19/1995
Registrant	McDONALD'S CORPORATION One McDonald's Plaza Oak Brook, IL 60523 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 042. First Use: 1976/00/00 First Use In Commerce: 1976/00/00
All goods and services in the class are requested, namely: restaurant services

Registration No	2289608	Registration date	10/26/1999
Registrant	McDONALD'S CORPORATION One McDonald's Plaza Oak Brook, IL 60523 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 030. First Use: 1998/04/19 First Use In Commerce: 1998/04/19

All goods and services in the class are requested, namely: specialty sandwich for consumption on or off the premises

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of:
Application Serial No. 77/722,272
Published in the *Official Gazette*
September 1, 2009

McDONALD's CORPORATION,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91192099
)	
McSWEET, LLC,)	
)	
Applicant.)	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION
AND COUNTERCLAIMS

Applicant, McSWEET, LLC, for its answer to the Notice of Opposition filed by McDONALD'S CORPORATION ("McDonalds"), against application for registration of McSWEET's trademark MCSWEET, Serial No. 77722272 filed April, 24, 2009, and published in the Official Gazette of September 1, 2009, pleads, avers, and seeks relief as follows:

ANSWER

1. Answering paragraph 1 of the Notice of Opposition, Applicant admits the allegations thereof.
2. Answering paragraph 2 of the Notice of Opposition, Applicant admits the allegations thereof.
3. Answering paragraph 3 of the Notice of Opposition, Applicant admits the allegations thereof.

4. Answering paragraph 4 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

5. Answering paragraph 5 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

6. Answering paragraph 6 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

7. Answering paragraph 7 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

8. Answering paragraph 8 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

9. Answering paragraph 9 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

10. Answering paragraph 10 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

11. Answering paragraph 11 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

12. Answering paragraph 12 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

13. Answering paragraph 13 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

AFFIRMATIVE DEFENSES

14. Applicant further affirmatively alleges that as a result of its continuous substantial usage of its mark MCSWEET since adoption, this mark is a valuable asset of Applicant and carries considerable goodwill and consumer acceptance of its products sold under the mark. Such goodwill and widespread usage has made the mark distinctive to the Applicant.

15. Applicant further affirmatively alleges that there is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark and the pleaded marks of Opposer are not confusingly similar. Any similarity, if at all, between Applicant's mark and the pleaded marks of Opposer is in the portion "Mc" which, upon information and belief, has been used and registered by numerous third parties in the foods, restaurant, processed foods and alcoholic beverages businesses. As a result, Opposer cannot base any similarity between its pleaded marks and the mark of Applicant of the "Mc." Any trademark or service mark rights that Opposer may have are narrowly circumscribed to the goods or services indicated and any other use would not lead to a likelihood of confusion.

16. Applicant further affirmatively alleges that there is no likelihood of dilution of Opposer's mark by tarnishment because Opposer's marks are associated with inexpensive, convenient or easy but low quality or commercialized versions of items whereas Applicant's mark is associated with high quality gourmet products.

17. Applicant further affirmatively alleges that there is no likelihood of dilution by blurring because Opposer's and Applicant's marks are not sufficiently similar; there are, upon information and belief, numerous uses and registrations of third party marks with the "Mc" formative; neither Applicant nor Applicant's predecessors in interest intended any association with Opposer's marks or any of them; and upon information and belief, ordinary prospective purchaser's of Applicant's products do not associate Applicant's and Opposer's marks.

18. Applicant further affirmatively alleges that there is no evidence that Applicant is not the actual owner of the MCSWEET mark because all evidence available supports that Applicant's use of MCSWEET in connection with pickled asparagus evidences and demonstrates McSweet, LLC's ownership of the mark.

CROSS CLAIMS

Applicant, McSWEET, LLC, doing business at P.O. Box 607, Maple Valley, Washington, 98038, believes that it will be damaged by Registration No. 1,118,362 for the mark McPIZZA; Registration No. 1,450,104 for the mark McNUGGETS; Registration No. 1,541,797 for the mark McCOLA; Registration No. 1,552,143 for the mark McCHILI; Registration No. 1,566,184 for the mark McCOOKIE; Registration No. 1,943,180 for the mark McCOFFEE; and Registration No. 2,289,608 for the mark McVEGGIE BURGER, registered to Opposer, McDONALD'S CORPORATION ("McDonald's"), located at McDonald's Plaza, Oak Brook, Illinois, 60531. Applicant hereby petitions to cancel in their entirety the registrations of the marks listed.

Applicant alleges and seeks relief as follows:

19. Applicant has continuously used the mark McSWEET since September 4, 2008, to the present, exclusively in interstate commerce and in commerce regulated by Congress in

connection with Applicant's goods and services, including the sale of "pickled asparagus" in International Class 29.

20. Applicant has used its global mark continuously for the goods and services specified for a period exceeding one year and the mark has acquired distinctiveness in connection with Applicant's goods and services.

21. Applicant has previously filed for registration of the mark McSWEET for use in connection with various pickled vegetable products, and has since amended its designation to "pickled gourmet vegetables, namely, pickled cocktail onions, pickled garlic, pickled, marinated olive medley, pickled green beans, and giardiniera, namely, a pickled celery, carrot, red pepper, garlic, green bean, and cucumber mix," also in International Class 29. Applicant and its predecessor in interest have used the mark continuously for pickled vegetables for a period exceeding 19 years and the mark has acquired distinctiveness in connection with Applicant's goods and services.

22. Applicant has applied for registration of its mark in International Class 29, Serial No. 77,722,272 as follows:

IC 029. US 046. G & S: Pickled asparagus.
FIRST USE: 20080904.
FIRST USE IN COMMERCE: 20080904

23. Applicant has used the mark McSWEET, in connection with various pickled vegetable products, since at least as early as 1999, and in connection with pickled asparagus since 2008; and Applicant's predecessor first used his mark in commerce since at least as early as 1990, in connection with processed vegetables. Opposer cites the referenced marks in support of its opposition to registration.

24. Applicant has expended considerable effort and expense in promoting its mark

McSWEET and the goods and services sold under such mark, with the result that the purchasing public has come to know, rely upon, and recognize the products of Applicant by such mark.

Applicant has an exceedingly valuable goodwill established by its McSWEET mark.

25. Applicant's McSWEET mark is not confusingly similar to Opposer's marks identified above and the goods and services sold under Opposer's marks.

26. McDONALD'S CORPORATION owns, operates, and controls the World Wide Web site www.mcdonalds.com.

27. McDONALD'S CORPORATION lists trademarks owned by the McDonald's Corporation and its affiliates on the World Wide Web site www.mcdonalds.com. However, Registration No. 1,118,362 for the mark McPIZZA; Registration No. 1,541,797 for the mark McCOLA; Registration No. 1,552,143 for the mark McCHILI; Registration No. 1,566,184 for the mark McCOOKIE; Registration No. 1,943,180 for the mark McCOFFEE; and Registration No. 2,289,608 for the mark McVEGGIE BURGER, are not included within those trademarks listed.

28. McDONALD'S CORPORATION includes a downloaded menu on the World Wide Web site www.mcdonalds.com that provides a list of the national food and beverage items offered at McDonald's restaurant, but this menu does not include Registration No. 1,118,362 for the mark McPIZZA; Registration No. 1,541,797 for the mark McCOLA; Registration No. 1,552,143 for the mark McCHILI; Registration No. 1,566,184 for the mark McCOOKIE; Registration No. 1,943,180 for the mark McCOFFEE; and Registration No. 2,289,608 for the mark McVEGGIE BURGER.

29. Registration No. 1,118,362 should be canceled under the Trademark Act § 14, 15

U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION included in its menu and advertised and promoted the mark McPizza in the late 1980s to early and mid-1990s. However, upon information and belief, the mark is no longer in use and, since the mid-1990s, has not been in use or in existence or good standing.

30. Registration No. 1,541,797 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

31. Registration No. 1,552, 143 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

32. Registration No. 1,566, 184 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

33. Registration No. 1,943,180 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site

www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

34. Registration No. 2,289,608 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

35. Registration No. 1,566,184 is registered in International Class 030 in connection with "soft serve ice milk sundaes for consumption on or off the premises." Registration No. 1,566,184 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned for nonuse in connection with the goods specified in the registration. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

36. Registration No. 1,450,104 is registered in International Class 042 in connection with "restaurant services." Registration No. 1,450,104 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned for nonuse in connection with the services specified in the registration. Upon information and belief McDONALD'S CORPORATION has a product on its menu and not a restaurant service that relates to this mark. Upon information and belief,

McDONALD'S CORPORATION never used or has discontinued the use of this mark in connection with restaurant services and it is no longer in existence or good standing.

Wherefore, Applicant deems that it is or will be damaged by Registration No. 1,118, 362 for the mark McPIZZA; Registration No. 1,450,104 for the mark McNUGGETS; Registration No. 1,541,797 for the mark McCOLA; Registration No. 1,552, 143 for the mark McCHILI; Registration No. 1,566, 184 for the mark McCOOKIE; Registration No. 1,943,180 for the mark McCOFFEE; and Registration No. 2,289,608 for the mark McVEGGIE BURGER, and petitions for cancellation thereof in their entireties. Applicant prays that this Petition for Cancellation be granted, that judgment be entered against Opposer, and that United States Registration Nos. 1,118, 362, 1,450,104, 1,541,797, 1,552, 143, 1,566, 184, 1,943,180, and 2,289,608 be canceled.

Dated this 6 day of November, 2009.

Respectfully submitted,

McSWEET, LLC

By: /Katherine Hendricks/

Katherine Hendricks

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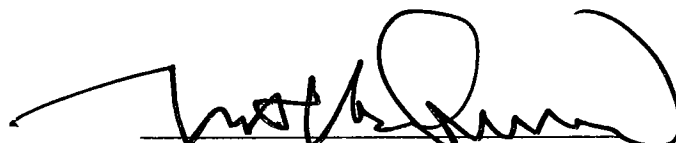
Attorneys for Applicant

Date: November 6, 2009

CERTIFICATE OF SERVICE

I hereby certify that on November 6, 2009, I served a true and complete copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIMS via email and First Class U.S. Mail, postage pre-paid, upon:

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